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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,816	04/19/2001	Hironori Osuga	33036W038	6211

7590

03/28/2003

Beveridge DeGrandi Weilacher & Young
Suite 800
1850 M Street NW
Washington, DC 20036

EXAMINER

SELLERS, ROBERT E

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 03/28/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

9

Office Action Summary

Application N .	Applicant(s)	
09/807,816	OSUGA, HIRONORI	
Examin r	Art Unit	
Robert Sellers	1712	

-- Th MAILING DATE of this communication appears on th cov r sh t with the correspond nce addr ss --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Shiobara et al. Patent No. 5,418,266.

Claims 1, 2, 4 and 6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Japanese Patent Nos. 11-71444 or 11-92631 or 11-130038 or 11-100490 or 11-100491.

Claims 1-7 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Takami et al.

Claims 1-7 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fujii et al.

Claims 1, 2, 4 and 6 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Shiobara et al. Patent No. 6,083,774.

Claims 1, 2, 4, and 6 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Okuse et al. or Arai et al. Patent No. 6,139,978.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arai et al. Patent No. 5,827,908.

The rejections are maintained for the reasons of record set forth in the previous Office action. The arguments filed March 24, 2003 have been considered but are unpersuasive.

The basis for the holding of inherency with respect to the claimed expressions of flexural modulus at molding temperature and percentages of cure shrinkage and heat shrinkage in the references is predicated upon the exemplification of compositions containing the identical naphthol-phenol novolac (Shiobara et al. '266), biphenyl and phenol-benzaldehyde novolac epoxy resins (Arai et al. '978); phenolic resins such as those represented by formulae (1), (2), (5) and (6) on pages 14 and 18 of the specification; triphenylphosphine curing accelerators and silica inorganic fillers. Each of the cited references is directed to the identical utility as that claimed as a semiconductor encapsulant.

The claimed expressions define warping according to page 7, line 25 to page 8, line 6 of the specification. Fujii et al., Arai et al. '978 and the Japanese patents acknowledge the reduced warpage of their formulations.

Accordingly, the position of inherency flows from a factual foundation regarding the identical types of components, utility and recognized reduced warpage declared in the applied prior art.

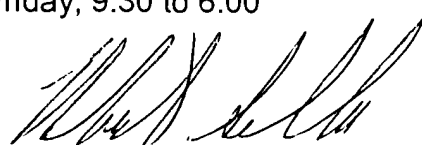
The evidence presented in Tables A and B on pages 6 and 7 of the amendment does not represent the closest prior art examples of the references cited in the previous Office action. The comparisons involving the phenol-benzaldehyde novolac epoxy resin of formula (1) and the phenol novolac resin of formula (2) in Table A, and the tetramethylbiphenyl epoxy resin of formula (3) with the phenolaralkyl resin of formula (5) in Table B do not represent the closest prior art combinations. Furthermore, the amounts of the epoxy resin and phenolic resin in the examples do not correspond to the exemplified proportions of the patents. Accordingly, the lack of inherent possession of the claimed warpage expressions has not been demonstrated to rebut the inherency endemic to the compositions of the references.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

(703) 308-2399 (Fax no. (703) 872-9311) Monday to Friday, 9:30 to 6:00

RS 3/27/03



ROBERT E.L. SELLERS
PRIMARY EXAMINER